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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/686,210	04/16/91	BERNAUER	IC 8468
EXAMINER			
REAMER, J			
ART UNIT	PAPER NUMBER		
1206	9		
DATE MAILED:		07/20/92	

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 3/26/92 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice re Patent Drawing, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, Form PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6. _____

Part II SUMMARY OF ACTION

1. Claims 1 To 39 are pending in the application.

Of the above, claims 8 To 10 + 16 To 30 are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 1 To 7, 11 To 15 + 31 To 39 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable. not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been approved by the examiner. disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed on _____, has been approved. disapproved (see explanation).

12. Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

Art Unit 1206

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1 to 7, 11 to 15 and 31 to 39 remain rejected under 35 U.S.C. § 103 as being unpatentable over Kitabara et al, British patent (2) or Miyamoto et al (3), for the reasons of record. Applicants admission that one can arrive at the instant compounds from the teaching of Kitabara et al is sufficient to maintain the rejection. The fact that one needs to assign specific functional groups to the variables is not sufficient evidence to render the teaching insufficient. The instant claims are broader than the genus of Kitabara et al. The reference need not teach the instant use since the claims to which the reference is applied are compound and composition claims. The composition claims are rejectable because they recite nothing more than the compound plus a carrier.

Art Unit 1206

The fact that the British patent does not teach a use for the compounds is not sufficient to negate the teaching since a patent is presumed to teach useful compounds. One skilled in the art would know how to use the compounds prepared by the British patent. The teaching of Miyamoto et al remains relevant absent evidence that the instant compounds posses unexpected properties over the compounds of Miyamoto et al.

Claims 1 to 7, 11 to 15 and 31 to 39 remain rejected under 35 U.S.C. § 103 as being unpatentable over Watsuka et al (4), for the reasons of record. The compounds of the reference may be taught to be useful as intermediates but the rejection is made against the compound claims. This utility is sufficient since the use claims are not being rejected. One needs a side-by-side comparison showing unexpected properties over the compounds of Watsuka et al to overcome this rejection.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

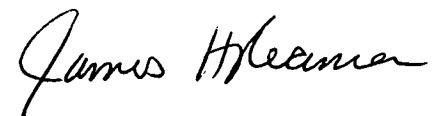
A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Serial No. 07/686,216

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Art Unit 1206

Any inquiry concerning this communication should be directed to Examiner Reamer at telephone number (703) 308-1235.



JAMES H. REAMER
PRIMARY EXAMINER
GROUP 120 - ART UNIT 126

REAMER:tce
July 17, 1992